

REMARKS

Applicants amended claims 103-112, 115-118, 121-123, 125, 129-133, and 136-138; and cancelled claims 113-114, 134, and 136. Claims 103-108, 110-112, 115-133, 135, and 137-138 are presented for examination.

The Examiner objected to claim 130 under 37 C.F.R. 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicants amended claim 130 to obviate this rejection, so this rejection should be withdrawn.

The Examiner rejected to claim 103-138 under 35 U.S.C. §112, first paragraph, for failing to comply with the enablement requirement. Applicants cancelled claims 113-114, 134, and 136 so the rejection of these claims should be withdrawn. As amended, claims 103-112, 115-133, 135, and 137-138 cover methods of prophylactically treating a condition including contacting a first area of a subject with a nanocrystalline metal-containing material to reduce the occurrence of the condition at a second area of the subject, where the condition is a microbial respiratory condition and the metal-containing material includes silver. Upon reading the specification, a person having ordinary skill in the art would understand that, for example, the nanocrystalline metal-containing material can reduce the occurrence of the condition at the prophylactically treated area of the subject by reducing the presence at the contacted area of the subject of one or more pathogens of the condition that can move from the first area of the subject to the second area of the subject. (*See, e.g.*, application, page 7, lines 25-30). Thus, by decreasing a microbial population at the nasal cavity and/or oral cavity, where respiratory infections are most likely to begin, the likelihood of contracting a microbial condition at the respiratory tract is reduced. Upon reading the application, a person having ordinary skill in the art would also understand that the nanocrystalline metal-containing material can be contacted with a subject's nasal cavity and/or oral cavity to reduce the occurrence of pneumonia in the lungs of the subject, and the nanocrystalline metal-containing material can be in the form of, for example, a solution, a mist, a swab, a sponge, a coated tube, a foam, a liposome, a tape, a pill, a capsule, a tablet, and/or a lozenge. (*See, e.g.*, application, page 8, lines 16-23). Further, Applicants provided numerous examples on methods of prophylactically treating ventilator-

associated respiratory conditions using nanocrystalline-silver containing material, for example, from page 52, line 6 to page 55, line 29 of the application. While these examples are prophetic, an applicant need not have actually reduced the invention to practice prior to filing. In Gould v. Quigg, 822 F.2d 1074, 1078 (Fed. Cir. 1987). Further, the specification need not contain an example if the invention is otherwise disclosed in such manner that one skilled in the art will be able to practice it without an undue amount of experimentation. In re Borkowski, 422 F.2d 904, 908 (CCPA 1970). Thus, as Applicants disclosed in detail the mechanism by which prophylaxis of microbial respiratory conditions can occur and provided ample guidance on methods of prophylactically treating a microbial condition, Applicants have satisfied the enablement requirement for claims 103-112, 115-133, 135, and 137-138, and the rejection of these claims under 35 U.S.C. § 112, first paragraph, should be withdrawn.

The Examiner rejected claims 103-104, 106-107, 109, 111, 115-116, 119-121, 124-127, 129-131, 133, and 136-138 under 35 U.S.C. § 102(b) as anticipated by WO 99/60999 ("Fleischer"). Applicants cancelled claim 136, so the rejection of this claim should be withdrawn. As amended, claims 103-104, 106-107, 109, 111, 115-116, 119-121, 124-127, 129-131, 133, and 137-138 cover methods of prophylactically treating a condition including contacting a first area of a subject with a nanocrystalline metal-containing material to reduce the occurrence of the condition at a second area of the subject. Fleischer does not disclose a nanocrystalline silver-containing material, as required by the claims. (See, e.g., Fleischer, abstract; page 1, lines 10-11; and page 5, lines 7). Therefore, Fleischer does not anticipate the subject matter covered by claims 103-104, 106-107, 111, 115-116, 119-121, 124-127, 129-131, 133, and 137-138. Accordingly, Applicants request that the rejection of these claims under 35 U.S.C. § 102(b) over Fleischer be withdrawn.

The Examiner rejected claims 103-104, 106-114, 116-129, 131, 133-134, 136, and 138 under 35 U.S.C. §§ 102(b) or 102(e) as anticipated by Derwent abstract 1994-089981 ("the Derwent abstract"), U.S. 6,899,933 ("Quillin"), U.S. 6,454,754 ("Frank"), or U.S. 7,087,249 ("Burrell"). Applicants cancelled claims 113-114, 134, and 136, so the rejection of these claims should be withdrawn. As amended, claims 103-104, 106-112, 116-129, 131, 133, and 138 cover

methods of prophylactically treating a condition including contacting a first area of a subject with a nanocrystalline metal-containing material to reduce the occurrence of the condition at a second area of the subject. None of the Derwent abstract, Quillin, Frank, or Burrell disclose such methods, at least because none of these references disclose prophylactically treating a condition with a nanocrystalline metal-containing material. Therefore, Applicants request that the rejection of claims 103-104, 106-114, 116-129, 131, 133-134, and 138 under 35 U.S.C. §§ 102(b) or 102(e) be withdrawn.

Applicants believe the application in condition for allowance, which action is requested.

Please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: April 13, 2007

/Sean P. Daley/
Sean P. Daley
Reg. No. 40,978

Fish & Richardson P.C.
225 Franklin Street
Boston, MA 02110
Telephone: (617) 542-5070
Facsimile: (617) 542-8906